

The opinion in support of the decision being entered is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY ALGREN and MICHAEL ASHER

Appeal No. 2007-1828
Application No. 10/772,811
Technology Center 3600

Decided: June 29, 2007

Before WILLIAM F. PATE, III, TERRY J. OWENS and LINDA E. HORNER,
Administrative Patent Judges.

PATE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-23. These are the only claims in the application. We have jurisdiction under 35 U.S.C. §§ 6 and 134.

Appellants claim an apparatus for moving particulate material such as grain. The apparatus consists of a body including a motor, a housing having a cavity, and a paddle assembly that actually contacts the grain and expels it forwardly.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. An apparatus for moving particulate matter, comprising:
a body having a motor;
a drive housing disposed on the body;
a cavity disposed in the body, the cavity having a first side, a second side, and at least a partial semi-circular cross-sectional shape;
a paddle assembly having a shaft and a plurality of paddles disposed therefrom, each paddle having a bottom wall and a distal end, wherein the distal end travels along the semi-circular cross-sectional shape of the cavity during operation, and the bottom wall extends along an entire width of the paddle in a substantially planar manner between the first side wall and the second side wall of the cavity and wherein each paddle includes a pair of side walls that in combination with the bottom wall define an open region; and
a drive mechanism disposed in the drive housing, the drive mechanism operatively connecting the motor and the shaft.

The references of record relied upon by the examiner as evidence of anticipation and obviousness are:

Guillemette	3,085,832	Apr. 16, 1963
Thorud	Re. 33,726	Oct. 29, 1991

Claims 1-7, 9-14, and 16-22 stand rejected under 35 U.S.C. § 102 as anticipated by Thorud.

Claims 8, 15, and 23 stand rejected under 35 U.S.C. § 103 as unpatentable over Thorud in view of Guillemette.

ISSUES

The issues raised by the appeal brief include the rejections based on lack of novelty and obviousness. Additionally, we *sua sponte* raise the issue of the definiteness of claims 1-8 and enter a rejection under 35 U.S.C. § 112, second paragraph, pursuant to our authority under 37 C.F.R. § 41.50(b).

FINDINGS OF FACT

Thorud discloses an apparatus for moving particulate matter, particularly, snow. Thorud uses a body having a motor 10. The body has a cavity having open face portion 14, a rearwall 18 and sidewalls 16 defining a partially semi-circular cross-sectional shape. The cavity encloses the paddle assembly 30. The paddle assembly is shown in Figures 2, 5 and 6. The paddle assembly has two paddles 32, which are identical in shape and are offset 180° from one another about paddle shaft 38. The paddles are actually comprised of two portions, a central section 34 and an end section 36 comprised of a “dog-eared portion” that acts as an auger to move snow towards central portion 34. Col. 5, ll. 46-54. The paddles of Thorud are complexly curved. The central portion 34 is of generally concave shape, shaped similar to a scoop, to concentrate the particulate matter into the central region and direct it upwardly and inwardly as shown by the vector arrows B in Figure 2. Col. 5, ll. 31-41. It is our view that this complexly curved impeller with a concave central portion cannot be said to be a paddle with a bottom wall arcuate about an axis parallel to the shaft, as required by claims 9 and 16. We agree with Appellants that the complexly curved central portion is concave or saddle shaped, and it is most significantly curved around an axis that is perpendicular to the paddle shaft. We acknowledge the Examiner’s reliance on Figure 6 of Thorud said to show the bottom wall arcuate about an axis parallel to the shaft. However, we

are in agreement with the Appellants that the periphery 32 shown in Figure 6 is an edge view of the paddle and does not represent a bottom wall that is arcuate about the axis that is claimed. Since we have found that Thorud does not disclose a paddle with a bottom wall arcuate about an axis parallel to the shaft, we do not sustain the Examiner's rejection of claims 9-14 and 16-22 under § 102.

Turning to the disclosure of Guillemette, we acknowledge the teaching of Guillemette that such particulate movers can be used not only for snow, but for throwing and blowing other materials such as grains, straw and the like. Col. 3, ll. 36-40. However, this teaching can in no way ameliorate the problems we have found with respect to the disclosure of the Thorud reference.

PRINCIPLES OF LAW

The prior art may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 907 (2003). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id.* In addition, “[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it.” *Id.*

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), the Supreme Court set out a framework for applying the statutory language of §103:

[T]he scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved

needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.*, at 17-18, 148 USPQ at 467.

While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid or unpatentable under §103. *See KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1388 (2007).

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious--the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Our analysis of the claims indicates that considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims needs to be made. A rejection under 35 U.S.C. § 103 should not be based on such speculations and assumptions. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962); *Ex parte Head*, 214 USPQ 551 (Bd. Pat. App. & Int. 1981).

Section 112, second paragraph, is satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in the context of the specification. *Marley Mouldings Limited v Mikron Industries, Inc.*, 417 F.3d 1356, 1359, 75 USPQ2d 1954, 1956 (Fed. Cir. 2005) (citing *Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692, 57 USPQ2d 1293, 1297 (Fed. Cir. 2001) (the definiteness requirement set forth in § 112, ¶ 2 focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification)); *Miles Labs., Inc. v. Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) (if the claims "reasonably

apprise those skilled in the art of the scope of the invention, § 112 demands no more"); *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) (the indefiniteness inquiry asks whether the claims "circumscribe a particular area with a reasonable degree of precision and particularity").

ANALYSIS

As noted above in our findings of fact, it is our view that the Examiner has not established that Thorud discloses a paddle with a bottom wall that is arcuate about an axis parallel to the paddle shaft. Accordingly, the rejections of claims 9-23 are reversed. We also reverse the rejections of claims 1-8, inasmuch as Thorud does not appear to show a paddle that is substantially planar. However, notwithstanding appellants' specification at line 14, of page 7, we do not regard the shape of the bottom wall 70 of appellants' paddle 56 as substantially planar. Both Figures 5 and 6 show that the bottom wall 70 is arcuate as claimed in claims 9 and 16. Therefore, we enter a rejection of claims 1-8 under 35 U.S.C. § 112, second paragraph, as misdescriptive of Appellants' subject matter. In other words, as recognized in Figures 5 and 6 and in Appellants' claims 9 and 16, the bottom wall 70 of the paddle disclosed by Appellants is arcuate. In our view, the arcuate portion of the bottom wall cannot be said to be substantially planar. This rejection is entered pursuant to our authority under 37 C.F.R. § 41.50(b).

CONCLUSION

The rejections of claims 1-23 under § 102 and § 103 are reversed. A new rejection of claims 1-8 under 35 U.S.C. § 112, second paragraph, pursuant to our authority under 37 C.F.R. § 41.50(b) is entered by the Board.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED; 37 C.F.R. § 41.50(b)

JRG

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